

REMARKS

Applicant requests reconsideration and withdrawal of the final rejections in the Final Office Action mailed June 23, 2009.

Applicant calls to the Examiner's attention the IDS filed on August 7, 2009.

Applicant respectfully **traverses** the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Nowers '359, and the rejection of claims 15-22 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Nowers in view of Wahle '409.

The primary basis for these traversals is that the prior art applied by the Examiner does not teach or even suggest **all the limitations** of the rejected claims 14-22, with particular emphasis on claim 15 (15/14).

1. **Claim 14** recites the following novel features:
 - a) *the outer cork paper of a filter (12) being provided with a plurality of openings (13) being subjected to a continuous checking process with respect to their number and size,*
 - b) *the size and number of openings (13) being checked by means of test air,*
 - c) *the test air being conducted through the filter cigarette or through the filter (12) as compressed air, with the air emerging from the openings (13) – exit air – being measured by pressure meters (46),*
 - d) *the pressure meter and a perforation element being connected to a computer (44), which evaluates the permanently or cyclically executed measurements in a control circuit and then controls the perforation element.*

The Office Action cites US 4 569 349 to Nowers against this claim 14 having this content. In principle, Nowers relates generally to Applicant's invention, namely to the production of filter cigarettes with a cork paper having openings. The concept of Nowers is summarized in col. 1, lines 21-31. That is, the openings can be applied to the "completed cigarette" or in the region of the "tipping paper". The latter is shown as an exemplary embodiment in the drawings. Furthermore, Nowers proposes "a first perforator ... and additional perforations ... by means of a controllable perforator", which here is configured as a laser. In principle, these features are shared by the present invention because the latter can also employ mechanical and/or laser-supported perforation devices.

Nowers' checking and measurement of the filter paper, however, deviates from the requirements of claim 14. The concept of Nowers is that the first perforation step (spiked roller 2) applies holes which are defined with respect to their number and size. This is followed by a measurement of the paper's "porosity". Depending on the results of measurement, further perforations are applied (by laser) if necessary. Nowers continually refers to "initial perforations" (col. 1, line 39/40) and to "additional perforations" (line 37/38). This "concept" also matches the exemplary embodiments shown in the patent's drawings.

In terms of measuring the "porosity", Nowers refers to a "porosity measuring device 5". The description of this device (col. 2, lines 9/11) is very sketchy. A pneumatic testing of the openings is supposed to be conducted by "measuring the pressure drop through the tipping paper". No further details are provided. In the view of Applicant, the person skilled in the art would not be able, on the basis of the extremely scanty information provided in col. 2, line 10/11, to understand how such a "porosity measuring device" is configured and operated. The

drawings in Fig. 1 and Fig. 3 show in any case that compressed (or suction) air is directed through the perforated web. The question as to how a precise measurement can be conducted with this arrangement remains unanswered.

The device according to claim 14 differs from Nowers in at least the following features:

- a) the test (compressed) air is directed into the filter (12) of the finished filter cigarette,
- b) the air exiting the openings of the finished filter cigarette is measured by the appropriate pressure meter,
- c) the pressure meter and the single perforation element are connected to a computer.

However, the central difference is that in Applicant's invention the finished cigarettes are subjected to a (continual) test. This yields the advantage that the effect of the perforation or holes in the tipping paper is tested on the finished product. The testing operation thus relates to the actual circumstances experienced by a smoker when consuming a cigarette. This is a decisive feature of the test concept.

2. Cited against claim 15 (15/14) is Nowers in view of US 4 193 409 to Wahle. A combined view of Nowers and Wahle does not in any way produce a device having the features of claims 15 and 14.

a) Nowers relates to the features of claim 14. A response to this has already been provided above. It should be noted in addition, however, that the comments on page 3, third paragraph, first sentence of the Office Action are inaccurate: Nowers teaches the measurement of "porosity" by means of a "pressure drop through the tipping paper". The corresponding feature of the present invention, however, is that test air, namely compressed air, is directed

through the filter so that the test air connected to the filter passes through the openings in the region of the tipping paper. A measurement is thus made which takes into account the flow characteristics of the filter in combination with the openings.

b) Wahle has also been incorrectly or insufficiently interpreted with respect to the claimed invention (page 3, third paragraph of the Office Action). There it is stated that: “Wahle discloses testing unit .. includes a chamber ..”. In actual fact, however, the testing of Wahle is made without a chamber. The cigarette is fixed in the testing unit (Fig. 4) between retaining elements 31A, 63. These elements abut exclusively – under tension – the ends of the cigarettes, namely at the tobacco end, on one hand, and at the filter end, on the other. Compressed air is introduced into the ends of the cigarette at both ends and via the retaining elements 31A and 63. However – and contrary to Applicant’s invention – no measurement is made of the air exiting from the region of the cigarette, in particular from the region of the openings. Instead, Wahle measures the pressure drop, or the degree of pressure, required to conduct a specific quantity of air through the cigarette. It is quite clear that the testing device of Wahle does not employ a chamber.

This also demonstrates a fundamental difference with respect to the testing method: the determining factor in Wahle is the exit of air along the entire length of the cigarette. Thus, it fails to take into account only the air exiting from the filter openings. If a cigarette is not tight, for example if there are holes in the region of the cigarette paper, this would have a distorting impact on the measurements. Wahle therefore tests the entire cigarette with respect to air flowing through it, while Applicant’s invention specifically focuses on the testing of openings in the region of the tipping paper.

The above arguments also apply to the independent claim 22.

The Examiner admits the novelty of claims 14-22.

In addition, however, there is also an **inventive step** and non-obviousness. In claims 14 and 15 (and 22) and particularly in claim 15, a testing system is established which is specially designed for the openings of a filter and which delivers particularly accurate test results by virtue of employing a delimited test chamber assigned to the filter. The invention tests for the first time the openings of the filter in a finished cigarette.

In summary, then, since Nowers, alone or in combination with Wahle, does not teach or even suggest **all the limitations** of claims 14-22, Applicant respectfully requests the Examiner carefully to reconsider and to withdraw the rejections under 35 U.S.C. § 103(a), and to find the Application to be in condition for allowance with all claims 14-22; however, if for any reason the Examiner feels that the Application is not now in condition for allowance, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Applicant files concurrently herewith a Petition (with fee) for Extension of Time of two months. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

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